

Oral Hearing held:
November 18, 2003

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Decision mailed:
March 31, 2006
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Oppedahl & Larson

Serial No. 75051843

Carl Oppedahl and Marina Larson of Oppedahl & Larson LLP for
Oppedahl & Larson.

Brett J. Golden, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney).

Before Quinn,* Hohein and Rogers, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Procedural Posture

Oppedahl & Larson has filed an application to register
on the Principal Register the term "PATENTS.COM" as a service
mark for "on-line information services in the field of

* As indicated in the order issued in connection with this appeal on March 11, 2005, Judge Quinn has been designated to substitute for Judge Cissel, who retired from Federal service after the oral hearing in this case but before an opinion was drafted and did not participate in the disposition or determination of any of the issues herein. See In re Bose, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985), *aff'g* 215 USPQ 1124, 1125 n.* (TTAB 1982), holding that (*italics in original*): "[T]here was no error in substituting a board member without allowing reargument. The statutory requirement that a case be 'heard' by three board members means *judicially* heard, not *physically* heard."

intellectual property law provided via [an] interconnected computer network linked by common protocols."¹

Registration has been variously refused on a number of grounds, including a final refusal, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that the term "PATENTS.COM" is generic for applicant's services because it designates a commercial website which provides information about patents. In addition, in the event that such term is not generic, registration has been repeatedly refused, under Section 2(e)(1) of the statute, on the ground that the term "PATENTS.COM" is merely descriptive of the subject matter of applicant's services and that applicant's showing in support of its alternative claim, under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f), that such term has acquired distinctiveness through use thereof in commerce is insufficient to overcome a finding of mere descriptiveness.² Registration has also been

¹ Ser. No. 75051843, filed on February 1, 1996, which as originally filed sought registration of such mark on the basis of Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), by setting forth a date of first use anywhere of July 1, 1995 and a date of first use in commerce of July 10, 1995. However, with the filing of applicant's second and operative appeal brief (its initially filed brief will not otherwise be considered since, as stated in the order issued herein on March 11, 2005, such brief pertains to a premature notice of appeal), applicant filed a "SUBSTITUTION OF BASIS" in which "applicant hereby substitutes §1(b) as a basis pursuant to MPEP [sic] section 806.03(c) and 37 CFR § 2.35." Subsequently, months after the oral hearing herein, applicant submitted an amendment to allege use in which it claims, as it did in the application as originally filed, a date of first use anywhere of July 1, 1995 and a date of first use in commerce of July 10, 1995.

² As set forth in the order issued herein on March 11, 2005, it is again pointed out that while, as indicated in *In re Capital Formation Counselors, Inc.*, 219 USPQ 916, 917 (TTAB 1983) at n. 2, the insufficiency of a showing pursuant to Section 2(f) is not itself a statutory basis for a refusal of registration on the Principal Register, the failure to make a sufficient showing of acquired distinctiveness precludes registration of a term which is otherwise

finally refused, under Sections 1, 2, 3 and 45 of the Trademark Act, 15 U.S.C. §§1051, 1052, 1053 and 1127, on the basis that the term "PATENTS.COM" fails to function as a service mark for applicant's services because, as used on the specimens of record, it would be perceived only as part of an Internet address for applicant's website.

Applicant has appealed. Briefs have been filed and an oral hearing was held.³ Thereafter, however, it came to the attention of the Board that applicant, in a related case in which it was seeking registration of the identical term "PATENTS.COM" as a trademark for "computer software for managing a database of records and for tracking the status of the records by means of

barred by the "merely descriptive" prohibition of Section 2(e)(1). However, in the case of a merely descriptive term which is generic, no showing of acquired distinctiveness would suffice for purposes of registration on the Principal Register. See, e.g., H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc., 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986) and authority cited therein ["A generic term ... can never be registered as a trademark because such term is 'merely descriptive' within the meaning of Section 2(e)(1) and is incapable of acquiring de jure distinctiveness under Section 2(f). The generic name of a thing is in fact the ultimate in descriptiveness"]. Thus, applicant's claim, in the alternative, of acquired distinctiveness would not suffice to overcome a possible finding that the term "PATENTS.COM" is generic for its services so as to permit registration.

³ Applicant, noting in particular the Examining Attorney's reliance in his brief upon the Board's decisions in *In re CyberFinancial.net*, 65 USPQ2d 1789 (TTAB 2002) and *In re Martin Container*, 65 USPQ2d 1058 (TTAB 2002), urges in its reply brief that "the issues under consideration in this case are ripe at this time for review by an *en banc* panel of the Trademark Trial and [Appeal] Board ..., rather than a simple panel, so that the issue of the special and frequently hostile treatment afforded by the Trademark Office to domain-name-related trademark applications can be fully ... addressed." Applicant, as noted in the order issued herein on March 11, 2005, was advised at the oral hearing that, to the extent it was requesting an *en banc* hearing and/or decision in this appeal, such request had been denied by Chief Administrative Trademark Judge Sams and that the denial thereof would be so noted.

the Internet,"⁴ had taken an appeal to the United States Court of Appeals for the Federal Circuit of a decision, by another panel of the Board, affirming a final refusal to register such term as merely descriptive of applicant's goods.⁵ In view of the potential bearing of the anticipated decision of the Federal Circuit, the Board in effect suspended issuance of a decision on the issues herein pending the final disposition of applicant's appeal in the related case.⁶

Following the issuance of a final decision in the appeal in applicant's related case,⁷ an order was issued on March 11, 2005 with respect to the preliminary matters raised by applicant's filing, with its second and operative appeal brief (hereinafter "main brief"), of its "SUBSTITUTION OF BASIS" and its submission, several months after the oral hearing, of its amendment to allege use. By such order, the Examining Attorney's objection to the substitution of basis filed by applicant was held to be untenable and, since such substitution otherwise

⁴ Ser. No. 78061755, filed on May 3, 2001, which was filed based on an allegation of a bona fide intent to use such term in commerce. Applicant subsequently filed an amendment to allege use, setting forth a date of first use and first use in commerce of December 9, 1999.

⁵ Specifically, the Board held that the term "PATENTS.COM merely describes applicant's computer software which tracks the status of patents and is available on the Internet." In re Oppedahl & Larson LLP, slip op. at 4 (TTAB April 16, 2003).

⁶ Plainly, both appeals involve the question of whether the term "PATENTS.COM," which is obviously formed by combining the word "PATENTS" with the top level domain designation ".COM," is at a minimum merely descriptive of the subject matter of applicant's goods and services.

⁷ In re Oppedahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370 (Fed. Cir. 2004).

complied with the applicable rules, the application accordingly stood amended to one seeking registration solely on the basis of an alleged bona fide intention to use.

Nonetheless, by its further amendment to allege use, applicant desires to convert its application back to one which seeks registration on the basis of use in commerce. The acceptability of such amendment, which is accompanied by a third specimen of use that differs from each of the other two specimens previously submitted, obviously has a direct bearing on the issues in this appeal. At a minimum, whether the amendment is allowed affects not only whether the refusal on the basis that the term "PATENTS.COM" does not function as a service mark is still part of this appeal, but also whether, if so, such ground remains viable. Consequently, the order issued on March 11, 2005 additionally provided that:

Accordingly, further disposition of this appeal is hereby suspended and the application is remanded to the Examining Attorney for consideration of the amendment to allege use. See TBMP §1206.01 (2d ed. rev. 2004) [it not only is the case that "an amendment to allege use filed during the pendency of an ex parte appeal to the Board is timely," but "[i]f an applicant which has filed a timely appeal to the Board files an amendment to allege use, in the application which is the subject of the appeal, more than six months after issuance of the appealed action, the Board may, in its discretion, suspend proceedings with respect to the appeal and remand the application to the examining attorney for consideration of the amendment to allege use"].

If the Examining Attorney determines that the amendment to allege use is acceptable, and finds that the specimen which accompanies the amendment evidences use of the term "PATENTS.COM" in such a manner that

it functions as a service mark for applicant's services, the Examining Attorney should so indicate in an Office action and return the application file to the Board for resumption of the appeal, at which point the Board will resume proceedings herein and issue a final decision with respect to the remaining issues before this panel. If, on the other hand, the Examining Attorney finds that the amendment to allege use is unacceptable and/or that the specimen which accompanies such amendment fails to evidence use of the term "PATENTS.COM" in such a manner that it functions as a service mark for applicant's services, then a new final refusal should be issued with respect thereto, and the Examining Attorney should thereafter return the application file to the Board for resumption of the appeal. Once the Board resumes proceedings herein, any refusals or requirements which are the subject of the new final refusal will be treated as part of this appeal and the Board will issue a schedule for supplemental briefing with respect thereto. Following receipt of such supplemental briefs, the Board will issue a final decision with respect to the remaining issues before this panel, including any issues raised by the new final refusal.

The Examining Attorney, upon remand of the application, issued an Office action on March 17, 2005 which states, among other things, that (emphasis in original):

Applicant's amendment to allege use is **accepted** and made part of the record. Accordingly, the refusal to register under Trademark Act Sections 1, 2[, 3] and 45, on the ground that applicant's specimen of record fails to exhibit use of the mark as a service mark, is **withdrawn**.

While the March 17, 2005 Office action also states that "[t]his application is returned to the Board for resumption of the appeal on the remaining issue, namely, whether applicant's mark may be registered on the Principal Register in accordance with Trademark

Act Section 2(f)," it is pointed out that such issue, which the Examining Attorney does not even argue in his brief,⁸ is not the sole issue remaining in this appeal. Rather, as previously noted, this appeal includes the issue of whether the term "PATENTS.COM" is generic for applicant's services in addition to the issues of whether such term is merely descriptive of the subject matter of applicant's services and, if so, whether applicant's showing in support of its alternative claim that such term has acquired distinctiveness through use thereof in commerce is insufficient to overcome a finding of mere descriptiveness.

Accordingly, and inasmuch as the Examining Attorney has accepted applicant's amendment to allege use and the adequacy of the accompanying specimen of use, as evidenced by the withdrawal of the refusal that as used the term "PATENTS.COM" fails to function as a service mark for applicant's services, this appeal is resumed and will go forward on the issues of whether such term is generic and, if not, whether it is merely descriptive of applicant's services and, if so, has acquired distinctiveness.

⁸ It is apparent, however, that despite the lack of any argument as to the issues of acquired distinctiveness and mere descriptiveness, the Examining Attorney does not admit or otherwise concede that the term "PATENTS.COM" is either suggestive or has been shown to have acquired distinctiveness. Instead, the Examining Attorney appears to take the position that he need not address the sufficiency of applicant's evidentiary showing or the question of mere descriptiveness because, as stated in his brief, "[i]f matter is generic, ... then the matter is unregistrable and a claim of acquired distinctiveness may not overcome a refusal to register." Nonetheless, the better practice in cases, such as the instant appeal, where an applicant is not only contending that a term is not generic but is arguing, alternatively, that even if such term were to be considered to be merely descriptive, it nevertheless has been shown to have acquired distinctiveness and hence is registrable, the Examining Attorney should also brief any alternative issues and not just address the question of genericness.

Genericness

We turn first to the issue of genericness. As set forth by our principal reviewing court in *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 728 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986), "[a] generic term is the common descriptive name of a class of goods or services." Such case also states the following as the legal test for whether a term which is asserted to be a mark, including one which includes a top level domain indicator (e.g., ".COM"), is considered to be generic:

Determining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or services at issue? Second, is the term sought to be registered ... understood by the relevant public primarily to refer to that genus of goods or services?

Id. However, as our principal reviewing court has also pointed out, a showing of the genericness of a mark requires "clear evidence" thereof. In *re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987).

Moreover, as such court noted in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832, 1837 (Fed. Cir. 1999), not only is it the case that "[t]he correct legal test" for genericness "is set forth in *Marvin Ginn*," but such test "is to be applied to a mark ... as a whole, for the whole may be greater than the sum of its parts," and the test "requires evidence of 'the genus of goods or services at issue' and the understanding by the [relevant] general public that the mark refers primarily to 'that genus of goods or services.'" In

particular, as recently noted by our principal reviewing court in
In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420, 1421
(Fed. Cir. 2005) (citations omitted):

An inquiry into the public's understanding of
a mark requires consideration of the mark as
a whole. Even if each of the constituent
words in a combination mark is generic, the
combination is not generic unless the entire
formulation does not add any meaning to the
otherwise generic mark.

With respect to the first prong of the genericness
test, applicant and the Examining Attorney would appear to agree
that the category or class of services at issue herein concerns
the providing of legal information about patents or intellectual
property through a website. Applicant, in this regard, asserts
in its main brief that:

Applicant wishes to register the mark
for "on-line information services in the
field of intellectual property law provided
via [an] interconnected computer network
linked by common protocols." In establishing
the [final] refusal to register, the
Examining Attorney states, "The term
'PATENTS' merely describes a type or category
of information provided on the applicant's
web site and is therefore a generic term for
such services." Accordingly, the genus of
services at issue here clearly relates to the
providing of information about patents or
intellectual property through a web site.

While the Examining Attorney, in his brief, does not specifically
address the first prong of the genericness test, he nonetheless
maintains that the term "'PATENTS' is commonly recognized as the
class or category of information provided on the applicant's web
site" and points out, in a footnote, that "the common usage of
the term 'PATENTS' as a type or category of intellectual property
is shown in dictionary definitions and LEXIS-NEXIS database

excerpts and may be gleaned from the applicant's specimens and numerous exhibits." Nothing in such contentions is thus at odds with his statement in the final refusal, with which applicant plainly agrees, that the category, class or genus of its "on-line information services in the field of intellectual property law provided via [an] interconnected computer network linked by common protocols" is essentially the "providing of information about patents or intellectual property through a web site."

Although, perhaps surprisingly, no corresponding statement specifically appears in the Examining Attorney's brief with respect to his discussion of the genericness issue, the record reflects that the above-quoted statement from the final refusal as to the first prong of the proper legal test for genericness is accurate and confirms that a principal aspect of applicant's services, as identified in the application, is indeed the "providing of information about patents or intellectual property through a web site." For instance, the specimens of use originally filed with the application, which consist of three copies of the October 1995 issue of the Oppedahl & Larson News newsletter, report that the "O&L Patent Law Information World Wide Web Site," which has "http://www.patents.com" as its Internet address, "contains hundreds of answers to frequently asked questions about patents and other intellectual property." In the same vein, the footer in the three copies of a January 25, 1996 e-mail sent by Carl Oppedahl on the "Subject: Mentioned in the trade ..." recites that "http://www.patents.com is a web server with frequently asked questions and answers on patent law

and other intellectual property subjects." Similarly, a printout of the "HotSites" page from the "InfoWorld" website lists three such sites for the "Week of November 3, 1997," including:

Patents.com <http://www.patents.com>

The law firm of Oppedahl & Larson offers the Intellectual Property Law Web Server, a compendium of patent, copyright, trademark, and trade secret information. Included are overviews of legal issues regarding software and Web content.

Another printout, from the "Nolo Press" website, sets forth five "Online Resources for Patents," including (in addition to a reference to the U.S. Patent and Trademark Office⁹):

<http://www.patents.com/> The patent law firm of Oppedahl and Larson is a good place to start when researching patent law.

Accordingly, in determining the first prong of the test for genericness, we find in light of the factual record that, while the genus or category of applicant's services is defined by the recitation thereof in the application as "on-line information services in the field of intellectual property law provided via [an] interconnected computer network linked by common protocols," such recitation must be interpreted, in light of the actual use being made of the term "PATENTS.COM" by applicant, as principally encompassing the inextricably intertwined element of providing legal information about patents, as well as other kinds of intellectual property, through a website. See, e.g., In re

⁹ Such reference reads as follows:

<http://www.uspto.gov> The U.S. Patent and Trademark Office is the place to go for recent policy and statutory changes and transcripts of hearings on various patent law issues.

Steelbuilding.com, supra at 75 USPQ2d 1422 [recitation of services interpreted in light of actual use being made of term "STEELBUILDING.COM"]; In re Reed Elsevier Properties Inc., 77 USPQ2d 1649, 1656 (TTAB 2005) [while the genus of services with respect to term "LAWYERS.COM" found to be "providing a web site with a database of information covering the identified topics of law, legal news and legal services," Board further found in view of actual use of such term that "a central and inextricably intertwined element of that genus is information about lawyers and information from lawyers" (footnote omitted)]; and In re DNI Holdings Ltd., 77 USPQ2d 1435, 1438 (TTAB 2005) [genus of services for determining whether term "SPORTSBETTING.COM" is generic includes wagering on sporting events and provision of information regarding sports and betting, since even though recitation of services in application excludes monetary wagering, evidence of record shows that website through which services were rendered offers sports betting services]. The focus of our inquiry, therefore, is whether, under the second prong of the test for genericness, the term "PATENTS.COM" is understood by the relevant public for applicant's services, as recited in the application, primarily to refer to a category or class (i.e., a genus) of providing information about patents, as well as other kinds of intellectual property, through a website.

Applicant, in its main brief, argues that in analyzing "whether the term sought to be registered is understood by the public to refer to the genus of services that involve the providing of information about patents or intellectual property

through a web site," the Examining Attorney "has taken the view that the mark may be dissected and that the four characters '.COM' may be ignored in this analysis." Specifically, applicant asserts that in refusing registration on the ground of genericness, "the Examining Attorney only considered the term PATENTS on the view that '.COM' does not function as an indicator of source." Applicant correctly points out, however, that as set forth by the Federal Circuit in *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1347, 57 USPQ2d 1807, 1811 (Fed. Cir. 2001) (which quotes from *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 545-46 (1920)): "The commercial impression of a trade-mark is derived from it as a whole, not from its elements separated and considered in detail."

Applicant, in light of the above, further contends in its main brief that:

The mark to be analyzed is and should be PATENTS.COM, but even if one assumes for sake of discussion that the mark is PATENTS, the genericness conclusion is in error. In either case, it is nearly inconceivable--and the Examining Attorney presents no evidence to the contrary--that the terms PATENTS or PATENTS.COM are used by the general public to describe the providing of information about patents or intellectual property on a web site. For a term to be generic, the term must be used to refer to a genus of goods or services. For instance, the mark THERMOS became generic for vacuum insulated containers In contrast, ... "patents" is a term that the public understands to be associated with physical items called "Letters Patent." Accordingly, PATENTS or PATENTS.COM is clearly not a generic term in regard to Applicant's services.

Moreover, as to the significance of the term ".COM" itself, applicant insists that the Examining Attorney is under the

"mistaken impression ... that '.com' means no more nor no less than that the owner [of a domain name with that term] is 'a commercial organization (business).'

Applicant argues that there are "[m]yriad other domain names ending in '.com' [which] are owned by individuals who are not commercial organizations and who do not carry out any business in connection with the domain names." According to applicant, "[d]omain names ending in '.com' are available on a first-come first-served basis for anyone to register and the Examiner has not provided (and cannot provide) any evidence of any enforcement mechanism that would check to see if a would-be owner of a '.com' domain name is a commercial entity or is a business."

Asserting, in addition, that unlike the situation in *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987), in which the term "SCREENWIPE" was held generic for a "pre-moistened, anti-static cloth for cleaning computer and television screens" because "[w]hether compounded as 'screen wipe'--two words--or 'screenwipe'--one word--either is ordinary grammatical construction," in the case of "PATENTS.COM" it is not "'ordinary grammatical construction' to use 'patents com' as a generic term for 'on-line information services in the field of intellectual property law provided via [an] interconnected computer network linked by common protocols.'" Applicant, in this regard, observes that "the Examiner has presented no evidence that it is 'ordinary grammatical construction' to use 'patents com' as a generic term" for such services. Applicant also notes that the Examining Attorney has failed to make of

record any third-party use of either the term "PATENTS.COM" or the words "patents com." In fact, as to the term "PATENTS.COM," applicant insists that "[s]uch a showing would be exceedingly unlikely, given that at most one entity may possess any particular domain name."

The Examining Attorney, relying principally on *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1792-94 (TTAB 2002) [holding the term "BONDS.COM" is generic for "information and electronic commerce services regarding financial products, including bonds, provided via the Internet"], and *In re Martin Container*, 65 USPQ2d 1058, 1060-62 (TTAB 2002) [finding the term "CONTAINER.COM" is generic for "retail services featuring metal shipping containers" and "rental of metal shipping containers"], argues on the other hand that the term "PATENTS.COM" is generic for applicant's services. In particular, he maintains in his brief that (footnotes omitted):¹⁰

¹⁰ The Examining Attorney requests that, "[f]or clarity, ... the Board ... take judicial notice of the dictionary entry for '.COM' from the computer dictionary at <http://www.techweb.com>, which is attached to this brief." We decline to do so, even though it is settled that, in general, the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981). Nonetheless, in the case, like herein, of on-line dictionary evidence submitted for the first time with the Examining Attorney's brief, the Board in *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999), stated with respect thereto that, "when Examining Attorneys intend to rely on Internet evidence that otherwise would normally be subject to judicial notice (such as dictionary definitions), such evidence must be submitted prior to appeal." In view thereof, the Examining Attorney's request that we take judicial notice of an on-line dictionary definition of the term ".COM" is denied.

Here, the ... mark at issue is no different from those in *Martin Container* and *CyberFinancial*--it is comprised of a generic term along with the top-level domain [("TLD")] ... indicator ".COM." The term "PATENTS" is defined as "a grant made by a government that confers upon the creator of an invention the sole right to make, use, and sell that invention for a set period of time." *The American Heritage Dictionary of the English Language* (3d. Ed. 1992) (electronic version) As demonstrated in the record, "PATENTS" is commonly recognized as the class or category of information provided on the applicant's web site and is therefore generic for the services. A term is generic if it reflects the class or category of information featured in the identified services, and, thus, the applicant's argument to the contrary is without merit. See *CyberFinancial* [65 USPQ2d] at 1792.

The term ".COM" is a top-level domain indicator for commercial web sites operating on the internet. See the dictionary evidence attached to the October 3, 1996 office action. It is well established that the top-level domain ".COM" has no source indicating significance and serves no trademark or service mark purpose. See *CyberFinancial* at [65 USPQ2d] 1792; *Martin Container* at [65 USPQ2d] 1060; *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1055 (9th Cir. 1999); *Northern Light Technology v. Northern Lights Club*, 97 F.Supp.2d 96, 110 (D. Mass. 2000) (TLD has "little importance" in distinguishing marks); *CCBN.com, Inc. v. c-call.com, Inc.*, 73 F.Supp.2d 106, 112 (D. Mass. 1999) (TLD has "no trademark significance").

The combination of the generic term "PATENTS" and the top-level domain indicator ".COM" in the proposed mark does not create any new meaning other than the meaning common usage would ascribe to them. The relevant public would immediately understand that the applicant provides a commercial web site featuring information in the class or category noted in the mark, namely, patents. Others would have a competitive need to use the matter sought to be registered as part of their own domain names and marks for similar

information services about patents. In accordance with *Martin Container* and *CyberFinancial*, therefore, the proposed mark is generic for the identified services As such, the proposed mark may not acquire distinctiveness under Section 2(f) of the Trademark Act, and registration is properly refused under Section 2(e)(1) ... of the Trademark Act.

In support of his position, the Examining Attorney asserts in a footnote to his brief that, as noted previously, "the common usage of the term 'PATENTS' as a type or category of intellectual property is shown in the dictionary definitions and LEXIS-NEXIS database excerpts and may be gleaned from the applicant's specimens and numerous exhibits." Although no particular definition or excerpt is specifically referred to, there can be no real question that the term "PATENTS" is generic with respect to the subject matter of applicant's legal services of providing information about patents, as well as other kinds of intellectual property, through a website, since such term plainly designates a category or class of intellectual property law information which applicant makes available. For instance, the definition of the word "patent" from The American Heritage Dictionary of the English Language (3rd ed. 1992) is more than sufficient to show the genericness of the term "PATENTS" in relation to applicant's services. Such definition (which is actually the sole definition thereof in the record) lists the word "patent" in relevant part as a noun signifying (as partially indicated previously) "1. a. A grant made by a government that confers upon the creator of an invention the sole right to make, use, and sell that invention for a set period of time. b.

Letters patent. **c.** An invention protected by such a grant" and as an adjective meaning, *inter alia*, "**1. a.** Protected or conferred by a patent or letters patent: a *patent right*. **b.** Of, relating to, or dealing in patents: *patent law*."

Also of record, as mentioned above, in support of the Examining Attorney's position with respect to the significance of the term ".COM," is "the dictionary evidence attached to the October 3, 1996 office action," which consists in pertinent part of the following definition from The Internet Dictionary (1995) at 54-55:

domain The main subdivision of Internet addresses, the last part of an Internet address after the final dot. In the United States, the standard domains are as follows:

Domain	Meaning
.com	Commercial
.edu	Educational
.gov	Government
.mil	Military
.org	Non-profit organization
.net	Network

Outside the United States, the top-level domain is usually the country domain, such as .ca for Canada, .de for Germany (Deutschland), .uk for the United Kingdom, and so on.

We judicially notice in the same vein that, for instance, The American Heritage Dictionary of the English Language (4th ed. 2000) defines ".com" at 367 as "*abbr.* commercial organization (in Internet addresses)," while the Microsoft Computer Dictionary (4th ed. 2000) at 95 likewise defines such term in pertinent part as "**1.** In the Internet's Domain Name System, the top-level domain that identifies addresses operated by commercial organizations. The domain name .com appears as a suffix at the end of the

address. Compare .edu, .gov, .mil, .net, .org." Moreover, contrary to the argument in its main brief, applicant in its response to the initial office action conceded that:

Persons familiar with the worldwide web know that sites on the web are accessed through an address (called a URL) which may, for example, have the format http://www.domainname.com, where "com" indicates that the domain is a commercial entity (as opposed to governmental, education or other type) and *domainname* is a unique identifier within the .com domains.

It is settled that a term is generic if it names a class of the services or goods to which it is applied. See, e.g., In re Dial-A-Mattress Operating Corp., supra at 57 USPQ2d 1810, *citing* In re Merrill Lynch, Pierce, Fenner & Smith, Inc., supra at 4 USPQ2d 1142, and H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., supra at 228 USPQ 530; Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531, 1533 (Fed. Cir. 1992); and In re Northland Aluminum Products, Inc., 777 F.2d 1566, 227 USPQ 961, 964 (Fed. Cir. 1985). Generic terms, however, are not limited to use as nouns designating a category, genus or type of product or service, but may also be used, for example, as adjectives. See, e.g., In re Pennzoil Products Co., 20 USPQ2d 1753, 1758-60 (TTAB 1991) ["MULTI-VIS" held generic for "multiple viscosity motor oil"]. Moreover, in making a determination of genericness, evidence of the relevant public's understanding of a term may be obtained from any competent source, including newspapers, magazines, dictionaries, catalogs and other publications, as well as the Internet. See, e.g., In re Northland Aluminum Products, Inc.,

supra at 227 USPQ 963; and In re Leatherman Tool Group Inc., 32 USPQ2d 1443, 1449 (TTAB 1994).

Furthermore, in the case of a compound term, our principal reviewing court in In re American Fertility Society, supra at 51 USPQ2d 1836, has pointed out that as set forth in In re Gould Paper Corp., supra at 5 USPQ2d 1110, 1111-12, not only does the test of whether a term is generic involve a determination of its primary significance to the relevant purchasing public, but the burden of proof of genericness, which is on the U.S. Patent and Trademark Office ("USPTO"), is satisfied by dictionary definitions showing that separate words joined to form a compound have a meaning identical to the meaning common usage would ascribe to those words as a compound. That is, if the USPTO can prove that the public understands the individual terms to be generic for a genus of goods or services and that the public also understands the joining of the individual terms into one compound word lends no additional meaning to the term, then the USPTO has proven that the public would understand the compound term to be generic in that it refers primarily to the genus of goods or services described by the individual terms. In re American Fertility Society, supra at 51 USPQ2d 1836. However, our principal reviewing court went on in such case to state that "Gould is limited, on its facts, language, and holding, to compound terms formed by the union of words" and that it is "legally erroneous" to apply the test therein for genericness of such terms "to phrases consisting of multiple terms, which are not 'joined' in any sense other than

appearing as a phrase." In re American Fertility Society, supra at 51 USPQ2d 1837.

We are therefore faced, in determining the second prong of the test for genericness, with the question of whether to treat the designation "PATENTS.COM" as a compound term, for which proof along the lines of that held sufficient in *Gould* may suffice, or whether to analyze such designation instead as a phrase, for which evidence of use thereof by the relevant public to refer to a category, genus or class of services like those offered by applicant would be necessary under *American Fertility Society*. To us, it is the former approach that is appropriate for analyzing an Internet domain name designation which is composed of a word, with an ordinary or commonly understood dictionary meaning, as the domain name together with a top-level domain ("TLD") indicator. See, e.g., In re Eddie Z's Blinds & Drapery Inc., 74 USPQ2d 1037, 1041-42 (TTAB 2005); In re CyberFinancial.Net Inc., supra at 65 USPQ2d 1794; and In re Martin Container, supra at 65 USPQ2d 1061. Treating a combination such as "PATENTS.COM" as a compound term rather than as if it were the phrase "PATENTS COM" is preferable since, due (presumably) to the technical requirements of Internet domain name addresses,¹¹ in our experience there can be no space

¹¹ For instance, as noted in In re DNI Holdings Ltd., supra at 1440-41:

As to domain names, presumably international protocols define a limited range of printable characters for second level domain names, including that they cannot contain spaces. We observe that, generally, adjacent words are simply run together in domain names (or at the very least, any spaces occurring naturally in normal English language

separating any of the individual terms which comprise an Internet address. Hence, because there could not ever be any third-party use of phrases such as, for example, "drugstore com" for on-line drugstore services, "bank com" for web-based commercial bank services or "supermarket com" for on-line retail supermarket services, a strict application of *American Fertility Society* rather than *Gould* plainly leads to the anomalous result that such unquestionably generic terms as "drugstore," "bank" or "supermarket," when coupled with the top level domain name ".com," could never be considered generic terms for the providing by a commercial entity, via the Internet, of, respectively, drugstore, commercial bank or retail supermarket services. Public policy, including the unfettered use of the English language, demands, however, in our view that in the context of the Internet, such terms as "DRUGSTORE.COM," "BANK.COM" or "SUPERMARKET.COM" should be treated as generic, just as the words "drugstore," "bank" or "supermarket" are generic for the corresponding brick and mortar enterprises. To do otherwise, and thus "[t]o allow trademark [or service mark] protection for generic terms, i.e., names which describe the genus of goods [or services] being sold, even when these have become identified with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods [or services] as what they are." In re Merrill Lynch, Pierce, Fenner, & Smith, Inc., supra at 4 USPQ2d 1142.

text must be replaced with a hyphen or similarly-approved characters [(e.g., an underscore: _)].

Accordingly, turning to the critical inquiry of whether, under the second prong of the test for genericness, the compound term "PATENTS.COM" is understood by the public for applicant's services to refer primarily to a category or class (i.e., a genus) of providing legal information about patents, as well as other kinds of intellectual property, through a website, we find that the Examining Attorney has shown by clear evidence that such is indeed the case. Obviously, the relevant public for applicant's services encompasses anyone interested in obtaining legal information about patents, whether such a person is, to cite a few examples, a new inventor or layman entrepreneur, an engineer or scientific researcher, or a patent agent or attorney. The dictionary definitions of "patents" and ".com" are sufficient to demonstrate that, when such terms are combined to form the designation "PATENTS.COM," they have a meaning in combination which, to the relevant public for applicant's services, is identical to the meaning which common usage by members of such public would ascribe to those words as a compound.

Specifically, the relevant public clearly understands the individual terms "patents" and ".com" to be generic for, respectively, a class or category of (i) intellectual property relating to or dealing in governmental grants, known as letters patents, that confer upon inventors the sole right to make, use, and sell their inventions for a set period of time and (ii) a top-level domain identifier of, in Internet addresses, any commercial organization or (as admitted by applicant) other commercial entity. Because the term "patents" is the generic

name for a class or category of intellectual property which constitutes, in significant part, the subject matter of its legal services of providing information about patents and other kinds of intellectual property law through a website, such term is likewise a generic name for those informational services as well. See, e.g., In re Candy Bouquet International Inc., 73 USPQ2d 1883, 1888 (TTAB 2004) ["[i]nasmuch as applicant is seeking to register a service mark ..., an additional principle applicable to our genericness determination in this case is that a term which is generic for a particular class of goods is also deemed to be generic for the services of selling those goods"]; In re CyberFinancial.Net Inc., supra at 65 USPQ2d 1790-92;¹² and In re Martin Container, supra at 65 USPQ2d 1060. Similarly, because the top-level domain indicator ".com" is a generic designation

¹² Along the same line, the Board in particular noted therein that:

The Board has held in the past that a term which is the generic name of a particular category of goods is likewise generic for any services which are directed to ... that class of goods. See: In re A La Vieille Russie Inc., 60 USPQ2d 1895 (TTAB 2001) [RUSSIANART generic for particular field or type of art and also for dealership services directed to that field]; In re Log Cabin Homes Ltd., 52 USPQ2d 1206 (TTAB 1999) [because LOG CABIN HOMES is generic for a particular type of building, it is also generic for architectural design services directed to that type of building, and for retail outlets featuring kits for construction of that type of building]; In re Web Communications, 49 USPQ2d 1478 (TTAB 1998) [because WEB COMMUNICATIONS is generic for publication and communication via the World Wide Web, it is also generic for consulting services directed to assisting customers in setting up their own Web sites for such publication and communication); and In re Harcourt Brace Jovanovich, Inc., 222 USPQ 820 (TTAB 1984) [LAW & BUSINESS incapable of distinguishing applicant's services of arranging and conducting seminars in the field of business law].

In re CyberFinancial.Net Inc., supra at 65 USPQ2d 1791.

for an Internet address or website run or sponsored by a commercial organization or entity, as opposed to, for instance, the government (".gov"), the military (".mil"), an educational institution (".edu") or a non-profit organization (".org"), the use thereof in connection with the applicant's services of providing information about the law of patents and other kinds of intellectual property through a website generically signifies that such legal services are provided by a commercial entity or business. See, e.g., In re CyberFinancial.Net Inc., supra at 65 USPQ2d 1792 ["[s]imply put, the TLD '.com,' as shown by the ... evidence, signifies to the public that the ... domain name constitutes a commercial entity"];¹³ and In re Martin Container, supra at 65 USPQ2d 1060 [term ".com," "to the average customer ..., would immediately indicate a commercial web site on the Internet"].

In view thereof, joining the terms "patents" and ".com" to form the designation "PATENTS.COM" results in a compound term which, to the relevant public for applicant's services of providing legal information about patents, as well as other kinds of intellectual property, through a website, primarily signifies a commercial website which provides legal information about

¹³ The Board, *inter alia*, noted therein that, as to such evidence:

The term ".com" is defined in the following ways: "a domain type used for Internet locations that are part of a business or commercial enterprise" [--] *CNET Glossary* (1998); "abbreviation of commercial organization (in Internet addresses)" [--] *The American Heritage Dictionary of the English Language* (4th ed. 2000); and "Internet abbreviation for company: used to show that an Internet address belongs to a company or business" [--] *Cambridge Dictionaries Online* (2001).

patents. See, e.g., In re Reed Elsevier Properties Inc., supra at 77 USPQ2d 1656 ["relevant public, including both lawyers and non-lawyers, when they consider LAWYERS.COM in conjunction with the class of involved services [which includes providing a website with a database of information covering the topics of law, legal news and legal services], would readily understand the term to identify a commercial web site providing access to and information about lawyers"]; CyberFinancial.Net Inc., supra at 65 USPQ2d 1794 ["finding that the designation BONDS.COM as a whole is no less generic than its constituents" with respect to information and electronic commerce services regarding financial products, including bonds, provided by way of the Internet]; and In re Martin Container, supra at 65 USPQ2d 1060 ["to the average consumer seeking to buy or rent containers, 'CONTAINER.COM' would immediately indicate a commercial web site on the Internet which provides containers"].

The relevant public for applicant's legal services, furthermore, would clearly understand that the joining of the individual terms "patents" and ".com" into the compound term "PATENTS.COM" lends no additional meaning to such term as a whole. While we are cognizant that our principal reviewing court in In re Steelbuilding.com, supra at 75 USPQ2d 1423, found that the composite term "STEELBUILDING.COM" was not generic because, "[i]n this unusual case, the addition of the TLD indicator expanded the meaning of the mark to include goods and services

In re CyberFinancial.Net Inc., supra at 65 USPQ2d 1791.

beyond the mere sale of steel buildings,"¹⁴ we fail to find any evidence on this record that the compound term "PATENTS.COM" analogously presents such exceptional circumstances. To be sure, in understanding such term as meaning primarily a commercial website which provides information about patent law, some members of the relevant public would think of a website which provides information about *obtaining* patents, that is, how to patent inventions, while other members, for example, would view the term "PATENTS.COM" as a website which provides information about *particular* patents which have issued and/or the status of pending patent applications. Still others, no doubt, would understand such term primarily as signifying a commercial website which provides essentially any type of information concerning patents, including both of the kinds of information mentioned above. Any of these understandings, however, would be generic inasmuch as, unlike the situation in *Steelbuilding.com*, in each instance the subject matter of applicant's commercial website is still the same--information about patents. See, e.g., *In re Reed Elsevier Properties Inc.*, supra at 77 USPQ2d 1656 ["the likelihood that some members of the relevant public would think of a web site providing online access to lawyers while others might think of a

¹⁴ The court, in this regard, further insisted with respect to "the effect of attaching the term '.COM' to 'STEELBUILDING'" that:

Specifically, the TLD expanded the mark to include internet services that include "building" or designing steel structures on the web site and then calculating an appropriate price before ordering the unique structure. The record, therefore, does not contain evidence sufficient to support the board's finding that "STEELBUILDING.COM" is generic for applicant's services.

web site providing online information about lawyers does not render LAWYERS.COM non-generic. Either understanding of the term would be generic and the fact that a term may have two generic meanings when considered in connection with a particular class of services does not mean it is not generic" (emphasis in original)] and cases cited therein.

We concede that the record contains no examples of third-party use of either the designation "patents.com" or the phrase "patents com,"¹⁵ nor has the Examining Attorney made of record any instances of third-party use, in connection with commercially provided on-line information services concerning patents, of Internet domain name addresses which incorporate the expression "patents.com" (such as, hypothetically speaking, "www.freeinformationaboutpatents.com," "www.internet-patents.com" or "www.law_firm_name_patents.com"). Such is not necessary,

In re In re Steelbuilding.com, supra at 75 USPQ2d 1423.

¹⁵ However, as previously noted in this opinion, evidence thereof simply is not likely to exist in the context of the Internet due to the technical requirement that there can be no space in the elements comprising a domain name. Thus, as applicant admits in its main brief:

In re Gould offers the Examiner one other way to justify a genericness refusal, namely to "show ... that the public uses it to identify goods [or services] of other producers as well." Such a showing would be exceedingly unlikely, given that at most one entity may possess any particular domain name. Were some other entity to offer "on-line information services in the field of intellectual property law provided via [an] interconnected computer network linked by common protocols" using the expression PATENTS.COM (perhaps in some way unrelated to a domain name, such as in the text of a web page), that entity would only serve to popularize the web site at which applicant offers the identified services. In any event the Examiner has made no such showing.

however, in order to for us to find that the primary significance of the term "PATENTS.COM" to the relevant public for applicant's services is as a reference to a category or class (i.e., a genus) of providing legal information about patents, as well as other kinds of intellectual property, through a commercial website. Nonetheless, in addition to our finding of genericness, we will now decide the remaining issues in this appeal (notwithstanding the absence of any briefing thereof by the Examining Attorney)¹⁶ in the interest of rendering a complete opinion on all of the issues presented.

Mere Descriptiveness

Considering next, therefore, the issue of whether the term "PATENTS.COM" is merely descriptive of the subject matter of its services, applicant argues among other things that, for technical reasons, any Internet domain name is inherently distinctive and thus cannot be merely descriptive. Specifically, applicant asserts in its main brief that "[e]very member of the public is well aware that only one entity is capable of owning any particular Internet domain name" (emphasis in original). Applicant consequently contends that "[i]n this context, anyone who sees 'PATENTS.COM' (or any other particular domain name) knows, therefore, that PATENTS.COM can be associated with only

¹⁶ As indicated earlier, the failure of the Examining Attorney to brief the remaining issues in this appeal, due to his insistence that the term "PATENTS.COM" is generic and that, as such, it cannot acquire distinctiveness, is not a concession of the remaining issues herein. However, to reiterate, the better practice would have been for the Examining Attorney to have briefed the alternative issues and not to rely solely upon an ultimate finding that the term "PATENTS.COM" is generic.

one entity, and that it cannot possibly be associated with more than one entity. As such it is automatically distinctive."

Applicant also points out that:

In this context it should be noted that the Examiner has not cited even a single use of the term PATENTS.COM in a descriptive sense, for example[,] by means of a Nexis computer search. It should also be noted that the Examiner has not cited even a single use of the term PATENTS.COM referring to goods or services of anyone other than the applicant.

As set forth in *In re Oppedahl & Larson LLP*, supra at 71 USPQ2d 1371-72, a recent case in which (as pointed out earlier) our principal reviewing court in applicant's companion application¹⁷ affirmed the Board's decision holding that the term "PATENTS.COM" is merely descriptive of "computer software for managing a database of records and for tracking the status of the records by means of the Internet":

A mark is merely descriptive if it "consist[s] merely of words descriptive of the qualities, ingredients or characteristics of" the goods or services related to the mark. *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents*, 252 U.S. 538, 543 (1920). Thus, a mark is merely descriptive if it immediately conveys knowledge of a quality or characteristic of the product. *Dial-A-Mattress*, 240 F.3d at 1346[, 57 USPQ2d at 1812]. A mark may be merely descriptive even if it does not describe the "full scope and extent" of the applicant's goods or services. *Id.* Descriptive marks can qualify for registration on the Principal Register if they acquire secondary meaning, i.e., distinctiveness. See 15 U.S.C. § 1052(f) (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769[, 23 USPQ2d 1081, 1083-84] (1992).

¹⁷ See footnote 4.

....

In *Dial-A-Mattress*, this court did not say, however, that the Board cannot ascertain the meaning of each of the words or components that make up the entire mark. In considering a mark as a whole, the Board may weigh the individual components of the mark to determine the overall impression or the descriptiveness of the mark and its various components. *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058[, 224 USPQ 749, 751] (Fed. Cir. 1985). Thus, the [US]PTO may properly consider the meaning of "patents" and the meaning of ".com" with respect to the goods [or services] identified in the application. However, if those two portions individually are merely descriptive of an aspect of appellant's goods [or services], the [US]PTO must also determine whether the mark as a whole, i.e., the combination of the individual parts, conveys any distinctive source-identifying impression contrary to the descriptiveness of the individual parts. *Id.*

In particular, as to the Board's finding of mere descriptiveness, our principal reviewing court further indicated and held that:

In this case, the Board concluded that ".com" conveys to the public that the mark is owned or used by a commercial entity or business. To support that conclusion, the Board cites various dictionary definitions indicating that ".com" is an abbreviation for "company" used in Internet addresses. Appellant argues that domain name registries no longer enforce the use of particular TLDs based on the type of entity seeking to register the domain name, i.e., ".com" for companies and ".org" for non-profit organizations. Regardless of the current state of Internet governance, the Board is correct that the overall impression of ".com" conveys to consumers the impression of a company or commercial entity on the Internet. "Any competent source suffices to show the relevant purchasing public's understanding of a contested term, including ... dictionary definitions." *Dial-A-Mattress*, 240 F.3d at 1345[, 57 USPQ2d at 1810]. Accordingly, substantial evidence supports the Board's

conclusion that ".com" indicates a commercial entity. Moreover, ... as qualified above, that impression bears no trademark significance. The dictionary definitions in the record also establish that ".com" conveys the use of the Internet in association with the mark. Appellant's identification of goods includes the use of the Internet. Accordingly, ".com" is descriptive of this feature of the goods listed in the application. Substantial record evidence also supports the Board's finding that "patents" is descriptive of a feature of the appellant's goods. Appellant's website shows that it offers software to track, *inter alia*, patent applications and issued patents using the Internet. Tracking patents falls within the scope of the goods identified in the application, i.e., "tracking records." Thus, the term "patents" describes a feature of the goods offered.

The Board also concluded that the combination of "patents" and ".com" does not render the mark as a whole distinctive and registrable. The Board reached this conclusion based on its application of the [*Goodyear's India Rubber Glove Manufacturing Co. v.*] *Goodyear [Rubber Co., 128 U.S. 598, 602-03 (1988)]* analysis, i.e., finding that ".com" holds no source-indicating significance just as [is the case with the term] "Corp." An analysis of the commercial impression of the mark as a whole as required under the analysis stated above still yields the same result on this record.

....

Appellant's goods include patent tracking software by means of the Internet. The term patents.com merely describes patent-related goods in connection with the Internet. The two terms combined do not create a different impression. Rather, the addition of ".com" to the term "patents" only strengthens the descriptiveness of the mark in light of the designation of goods in the application. "Patents" alone describes one feature of the goods--that of tracking patent applications and issued patents. Adding ".com" to the mark adds a further description of the Internet feature of the identified goods. Thus, appellant's argument to

consider the mark as a whole only strengthens the descriptiveness finding.

Id. at 71 USPQ2d 1373-74.

Moreover, as to applicant's argument, also raised herein, that a domain name such as "PATENTS.COM" cannot be merely descriptive because it is inherently distinctive, our principal reviewing court specifically pointed out and found with respect thereto that:

Appellant asserts that domain names are inherently distinctive because they can only be associated with one entity or source at a time. The simple fact that domain names can only be owned by one entity does not of itself make them distinctive or source identifying. Telephone numbers and street addresses are also unique, but they do not by themselves convey to the public the source of specific goods or services. Thus, this court declines to adopt a per se rule that would extend trademark protection to all Internet domain names regardless of their use. Trademark law requires evaluation of a proposed mark to ascertain the commercial impression conveyed in light of the goods or services associated with the mark, not a simple check for ownership of an Internet address.

....

When examining domain name marks, the [US]PTO must evaluate the commercial impression of the mark as a whole, including the TLD indicator. The addition of a TLD such as ".com" or ".org" to an otherwise unregistrable mark will typically not add any source-identifying significance, similar to the analysis of "Corp." and "Inc." in *Goodyear's [India] Rubber [Glove] Manufacturing Co.*, 128 U.S. at 602. This, however, is not a bright-line, per se rule. In exceptional circumstances, a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration. In this case, the mark patents.com, as a whole, is merely

descriptive of appellant's goods. The decision of the Board is affirmed.

Id. at 71 USPQ2d 1374.

In light of the above, and based on the dictionary definitions and other evidence before us, it is apparent that the term "PATENTS.COM" is merely descriptive of applicant's "on-line information services in the field of intellectual property law provided via [an] interconnected computer network linked by common protocols." Plainly, patents are one of the principal subjects of applicant's Internet-based intellectual property law information services as evidenced by, for instance, the third specimen of use, which applicant submitted with its amendment to allege use. Among other things, such specimen, which consists of a screen-print of applicant's "Welcome to the *patents.com* Intellectual Property Law Web Server" webpage (italics in original), states that "Oppedahl & Larson LLP is a law firm offering patent, copyright, trademark, trade secret, and other intellectual property services"; recites that "This Web server is intended to provide information about intellectual property and about the firm"; and contains a link entitled "General information about patents" as the first in a listing of four links, which also include those denominated "General information about copyrights," "General information about trademarks" and "General information about trade secrets." Clearly, as was analogously the case in *Oppedahl*, the term "PATENTS.COM" merely describes patent-related legal services in connection with the Internet. Specifically, to the relevant public for applicant's services, including laymen interested in obtaining information

about patents, such as general information about patent law, combining the terms "PATENTS" and ".COM" into the compound term "PATENTS.COM" results in a designation which would only signify a commercial website which provides legal information about patents. Id. at 71 USPQ2d 1374.

The combination, moreover, of the terms "PATENTS" and ".COM" to form the compound term "PATENTS.COM" does not create a different connotation which is suggestive or otherwise source-indicative. Rather, the addition of ".COM" to the word "PATENTS" serves to strengthen the mere descriptiveness of the term "PATENTS.COM" in light of applicant's services as recited in its application. The word "PATENTS" alone merely describes one significant feature of such legal services--that of commercially providing information on the subject of patents. Adding ".COM" thereto merely adds a further description of the Internet or web-based feature of applicant's services. Thus, as was found in *Oppedahl*, considering the term "PATENTS.COM" "as a whole only strengthens the descriptiveness finding." Id. at 71 USPQ2d 1374. Likewise, as indicated in the even more recent case of *In re Steelbuilding.com*, supra at 75 USPQ2d 1423-24, our principal reviewing court, in upholding the Board's finding of mere descriptiveness with respect to the term "STEELBUILDING.COM" for, *inter alia*, computerized on-line retail services in the field of pre-engineered metal buildings and roofing systems,¹⁸ held that:

¹⁸ In particular, the court found among other things that:

The Board also considered whether the mark STEELBUILDING.COM was, if not generic, then at least merely descriptive. The applicant's web site lists as its first

The Board also considered how the TLD indicator may have affected descriptiveness. The Board correctly observed that adding ".COM" to "STEELBUILDING" "simply means that services ... are performed in an on-line or 'e-commerce' environment." Indeed, the TLD indicator describes a significant feature of applicant's services, namely, the Internet commerce connection. Thus, the record sustains the Board's determination that applicant's mark is "merely descriptive" for the on-line services specified in the application.

Furthermore, we fail to see anything in the evidentiary record herein which presents such exceptional circumstances that the combined term "PATENTS.COM," when used in connection with applicant's services, would not be considered merely descriptive because the combination of the terms "PATENTS" and ".COM" results in a whole greater than the sum of its parts. In particular, as noted in this regard by our principal reviewing court in *In re Steelbuilding.com*, supra at 75 USPQ2d 1422:

Only in rare instances will the addition of a TLD indicator to a [merely] descriptive term operate to create a distinctive mark. *Oppedahl*, 373 F.3d at 1175[, 71 USPQ2d at 1373]. In those rare instances, a term that

feature: "Design your *steel building* with our advanced interactive system." (Emphasis added). One of applicant's advertisements includes the following sentence: "E-Commerce website offers instant pricing and on-line sales of *steel buildings*, mini storage systems, building accessories, component parts and all-*steel* homes." (Emphases added). Based on this evidence and more in the record, this court concurs in the statement of the Board: "[w]e, frankly, are at a loss to understand that if the retail sale of steel buildings is not the primary feature of applicant's services, what is. However, whether steel buildings are the 'primary feature' of applicant's services is not determinative, because they are at least a significant feature of applicant's services." *Steelbuilding.com*, 2003 WL 23350100, at *9. For descriptiveness, the record shows that a consumer would recognize the compound word "STEELBUILDING" as conveying the same impression, at least for trademark purposes, as the phrase "steel buildings."

is not distinctive by itself may acquire some additional meaning from the addition of a TLD, such as ".com," ".net," etc. See *id.* at 1175-76[, 71 USPQ2d at 1373-74.] In those unusual circumstances, the addition of the TLD can show Internet-related distinctiveness, intimating some "Internet feature" of the item. See *id.* at 1178[, 71 USPQ2d at 1374.] Because the evaluation of a mark proposed for registration requires consideration of the mark as a whole, the distinctiveness derived from a connection to the Internet, as indicated by the TLD indicator, is a part of the calculus for registration.

Here, however, as explained above, the addition of the TLD indicator ".COM" to the word "PATENTS" to form the term "PATENTS.COM" adds nothing more than merely describing the Internet or web-based feature of applicant's commercially provided legal information services on the subject of patents. See *In re Oppedahl & Larson LLP*, supra at 71 USPQ2d 1374.

Finally, as to applicant's contention that the Examining Attorney has failed to submit any evidence of third-party use of the term "PATENTS.COM" in a descriptive manner, suffice it to say that it is well settled that the fact that applicant may be the first and/or sole user of a merely descriptive term does not entitle it to registration thereof where, as here, the other evidence of record demonstrates that the term projects only a merely descriptive significance in the context of applicant's services. See, e.g., *In re National Shooting Sports Foundation, Inc.*, 219 USPQ 1018, 1020 (TTAB 1983); and *In re Mark A. Gould, M.D.*, 173 USPQ 243, 245 (TTAB 1972).

Acquired Distinctiveness

This brings us to consideration of the sufficiency of applicant's alternative claim that the term "PATENTS.COM" has acquired distinctiveness through use thereof in commerce. Applicant argues in its main brief that it has submitted sufficient evidence of acquired distinctiveness, including an "uncontroverted" declaration by Carl Oppedahl, dated July 10, 2000, which in relevant part attests that "[t]he mark PATENTS.COM has become distinctive of the goods (or services) through the applicant's substantially exclusive and continuous use in commerce for at least the five years immediately before the date of this statement." Applicant, while maintaining that such declaration *per se* is sufficient to demonstrate acquired distinctiveness, also asserts that "the record shows thousands of instances of uses by third parties of PATENTS.COM to refer specifically to goods or services of the applicant" and insists that "[n]othing in the present record controverts the myriad objective indicia of distinctiveness shown in these submissions." In consequence of all the evidence which it has furnished, applicant urges that it "has provided extensive evidence of public recognition of PATENTS.COM as a source of services that relate to the providing of information about intellectual property."

In support of its position, applicant has submitted, in addition to the above-noted declaration of Carl Oppedahl,¹⁹ the

¹⁹ The record also contains an earlier declaration from Mr. Oppedahl which applicant briefly mentions in its main brief. Specifically, such declaration recites that "[a]ttached is a page showing the results of a search on Altavista which" he "personally performed today, August 27, 1998"; that he "searched for web sites satisfying

declarations, with exhibits, of Marina T. Larson, dated April 3, 1997, and Stanley D. Ference III, dated December 23, 1997. Ms. Larson's declaration, *inter alia*, attests that she is a general partner in applicant; that as shown by the statistics page attached as Exhibit A, which shows "the number of visitors to the patents.com web site since February 1996," such site "has had more than 44,000 [visitors] in just over a year, or an average of more than 100 visitors per day"; that "[m]ost of these visitors either typed the name 'patents.com' or highlighted a selection in a web page," which "highlighting generally results in the name of the web site ... being displayed on the web browser being employed"; that "the patents.com web site has been cited by over 300 other web sites, including web sites maintained by the U.S. House of Representatives, and the US Patent and Trademark Office (before it stopped mentioning any law firm wen [sic] sites"; that "[p]rintouts of several web pages which refer to the patents.com web site are attached as Exhibit B"; that a "list of web sites which now cite or in the past (the web is fluid and changes frequently) have cited the patents.com web site is attached as Exhibit C"; that the "patents.com web site has been referred to in magazines and newspaper articles as a source of information

the condition: www.patents.com and not host:patents.com"; that "[t]his condition finds web pages that link to the patents.com web site"; that "[o]n most of these pages, the link occurred because someone made the individual decision to create the link," that is, "the link is not the result of some automated process but is the conscious act of the webmaster for the particular page"; and that "[t]his is objectively measurable proof of the secondary meaning associated with the mark." None of the examples of such links, we observe, evidence any use of the term "PATENTS.COM" itself, however. At best, such evidence may only show recognition of www.patents.com as

about intellectual property law"; and that copies "of some of these references are attached as Exhibit D."

Ms. Larson also avers in her declaration that, as shown by Exhibit E, the "patents.com web site has been used as source material in eleven college courses relating to intellectual property and web law"; that such site "has been cited in USENET postings and in e-mail as a source of information on a variety of topics relating to intellectual property law"; that copies of "[s]ome of these communications are attached as Exhibit F"; that as shown in the copies of an accompanying e-mail submitted as a substitute specimen, such e-mail "contained a footer directing recipients of the e-mail to patents.com as a source of information about intellectual property"; that footers "of this type are automatically appended to outgoing e-mail messages"; and that "[t]his footer was in use and being appended to outgoing e-mail messages prior to the filing of the present application.

We observe, however, that with only one exception, none of the exhibits evidences use of "patents.com," much less the use of such term in the manner of a service mark. Instead, with respect to certain links, they either consist of other words, e.g., "Oppedahl & Larson" or "Intellectual Property Law Web Site created by the good people at the Oppedahl & Larson patent law firm," with an accompanying hand-written notation such as, for instance, "points to patents.com," or they simply show use thereof in a way which would be perceived as nothing more than

a website address and does not show recognition of "PATENTS.COM" as a service mark.

applicant's domain name address or location on the Internet where applicant's website appears, that is, as "http://www.patents.com" or "www.patents.com." See, e.g., In re Eilberg, 49 USPQ2d 1955, 1957 (TTAB 1998) [term "WWW.EILBERG.COM" fails to function as a service mark for legal services because, as used on letterhead stationery, "the asserted mark identifies applicant's Internet domain name, by use of which one can access applicant's Web site," that is, it "merely indicates the location on the Internet where applicant's Web site appears"]. The single exception is a reference to "Patents.com by Oppedahl & Larson," which appears on a webpage provided by "Computer Tutor, Inc. of Fort Collins[, Colorado" under the notation "Links to additional trademark information:" along with several other references, including "U.S. Patent & Trademark Office (USPTO)," "General Information about Web Law by Oppedahl & Larson," "Trademarks & Business Goodwill by Franklin Pierce Law Center **GOOD INFO!**" and "Avoiding Trademark Infringement by Franklin Pierce Law Center **EXCELLENT!**" (emphasis in original). Furthermore, as to the averment that "the number of visitors to the patents.com web site since February 1996" has amounted to "more than 44,000 in just over a year, or an average of more than 100 visitors per day," we note that tellingly there is not a single example of the manner, if any, in which the term "PATENTS.COM" was featured or otherwise displayed on any webpages at applicant's website during such period.

The declaration of Mr. Ference recites, in relevant part, that he is "a partner of the law firm of Oppedahl &

Larson"; that "[a]ttached as Exhibit A is a copy of the InfoWorld HotSites listing for the week of November 3, 1997, which includes Applicant's *patents.com* web site"; that such exhibit also includes "a copy of the HotSites Archive, which is a collection of over 500 sites described as pertinent to InfoWorld readers" and which shows that "[t]he *patents.com* site is the only site listed for providing legal information"; that "[a]ttached as Exhibit B is a copy of the homepage of the National Council of Intellectual Property Associations," which "organization lists four private web sites for obtaining information on intellectual property law, one of which is Applicant's *patents.com* web site"; that "[a]ttached as Exhibit C is a printout of the intellectual property online resources page from the Nolo Press web site"; that "[f]ive web sites are listed, two of which are maintained by private law firms," of which "[o]ne of these web sites is Applicant's *patents.com* web site"; that "[a]ttached as Exhibit D is a printout of the intellectual property firms indexed by the *yahoo.com* Internet search engine"; that such printout "lists over 190 law firms, the listings for only 11 of which indicate the web site provides any information above and beyond information concerning the firm"; and that "[o]ne of these 11 web sites is Applicant's *patents.com* web site."

Mr. Ference further states in his declaration that "Network Solutions, Inc. is the domain name registrar for the .COM domain among others"; that, on information and belief, "as of November 1997 the size of Network Solution's registration database was approximately 1,300,000"; that "[a]ttached as

Exhibit E is a copy of a statistics page showing the number of visitors to the *patents.com* web site since February 1996, as of August 27, 1997"; that such page "shows that during the preceding two week period Applicant's *patents.com* web site had over 12,000 hits"; that "[a]ttached as Exhibit F is a copy of a statistics page showing the number of visitors to the *patents.com* web site since February 1996, as of December 22, 1997"; and that such page "shows that during the preceding two week period Applicant's *patents.com* web site had over 51,700 hits."

While we note that the printout of the "HotSites" page from the "InfoWorld" website (reproduced in relevant part previously in this opinion) does indeed evidence use of the term "Patents.com," as a link to applicant's "http://www.patents.com" website, in the manner of a service mark, the "HotSites Archive" to which Mr. Ference refers does not contain a separate listing of law firms or websites providing legal information. Instead, its listings are broken down under the five separate categories of "Major Computer Vendors," "Software Companies," "Hardware Companies," "Networking Companies" and "Technology and the Internet," of which none would seem likely to list providers of legal information. As to the reference to applicant's website in the homepage of the National Council of Intellectual Property Associations, we observe that such page does not refer to the term "patents.com" in a service mark manner but instead uses applicant's Internet domain name address as part of the following statement: "Oppedahl and Larson, Yorktown Heights, NY - General IP info. (E. Cabic); *www.patents.com*." We likewise note that the

Nolo Press printout does not evidence use of "patents.com" in the manner of a service mark; instead, it utilizes applicant's Internet domain name address as part of the following statement: "<http://www.patents.com/> The patent law firm of Oppedahl and Larson is a good place to start when researching patent law." The *yahoo.com* Internet search engine printout, we notice, does not contain any reference to either "patents.com" or applicant's Internet domain name address; rather, it simply sets forth the following statement: "[Oppedahl & Larson Patent Law Firm](#) - answers to frequently asked patent questions."

Moreover, with respect to the sworn allegations that the number of visitors to the *patents.com* web site during the two weeks prior to August 27, 1997 was recorded as amounting to "over 12,000 hits" and that the number of such visitors during the two weeks prior to December 22, 1997 was recorded as growing to "over 51,700 hits, we observe that notably there is not even one example of the way, if any, in which the term "PATENTS.COM" was featured or otherwise displayed on any webpages at applicant's website during such periods. The sole instance, on this record, in which the term "PATENTS.COM" is in fact used in the manner of a service mark for applicant's services of providing information on patents and other types of intellectual property is, we note, the third specimen of use (described previously in this opinion in connection with the discussion of mere descriptiveness), which applicant submitted with the amendment to allege use which it filed on June 28, 2004.

As pointed out by our principal reviewing court in *In re Steelbuilding.com*, supra at 75 USPQ2d 1424, in upholding the Board's finding that acquired distinctiveness had not been shown with respect to the merely descriptive term "STEELBUILDING.COM:

[T]he Board considered whether the mark had acquired distinctiveness, or secondary meaning. In determining whether secondary meaning has been acquired, the Board may examine copying, advertising expenditures, sales success, length and exclusivity of use, unsolicited media coverage, and consumer studies (linking the name to a source). *Cicena Ltd. v. Columbia Telecomms Group*, 900 F.2d 1546, 1551[, 14 USPQ2d 1401, 1406] (Fed. Cir. 1990). On this list, no single factor is determinative. A showing of secondary meaning need not consider each of these elements. Rather, the determination examines all of the circumstances involving the use of the mark. *See Thompson Med. Co., Inc. v. Pfizer Inc.*, 753 F.2d 208, 217[, 225 USPQ 124, 132] (Fed. [sic; 2d] Cir. 1985). Finally, the applicant's burden of showing acquired distinctiveness increases with the level of descriptiveness; a more descriptive term requires more evidence of secondary meaning. *In re Bongrain Intern. (Am.) Corp.*, 894 F.2d 1316, 1317[, 13 USPQ2d 1727, 1729] (Fed. Cir. 1990) ("the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning").

In particular, after agreeing with the Board's finding therein that a survey "did not show sufficient reliability to constitute sufficient evidence of acquired distinctiveness" (since among other things, as indicated by the Board, "occasionally, people may recognize applicant's term as a trademark but much of this evidence may be attributable to domain name recognition"), the court further noted and held that:

The Board considered other evidence as well, but none of that evidence established the proposed mark's distinctiveness. The

proposed mark is highly descriptive. Therefore, applicant had the burden to show a concomitantly high level of secondary meaning. The Board correctly determined that, on this record, "applicant's evidence falls far short of its burden."

Id.

By the same token, applicant's evidence herein falls far short of its burden of demonstrating acquired distinctiveness with respect to the term "PATENTS.COM," which we find to be highly descriptive of applicant's services of providing information about patents and other intellectual property law topics via a commercial website. Given that "the greater the degree of descriptiveness the term has, the heavier the burden to prove it has attained secondary meaning," *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1008 (Fed. Cir. 1988), applicant's mere claim of five years substantially exclusive and continuous use of the term "PATENTS.COM" alone is plainly insufficient as proof of acquired distinctiveness. See TMEP Section 1212.05(a) (4th ed. 2005) ["[i]f the mark is highly descriptive ... of the ... services named in the application, the statement of five years' use alone will be deemed insufficient to establish acquired distinctiveness"], citing *inter alia* *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490, 1492 (TTAB 1989) and *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987). Buttressing our conclusion in this regard is the fact that neither of the specimens of use which applicant submitted during the five-year time period covered by the Oppedahl declaration of substantially exclusive and continuous use demonstrates use of the term "PATENTS.COM" in

the manner of a service mark; instead (as mentioned previously), such term is used solely as part of the Internet domain name address for applicant's commercial patent and other intellectual property law website, namely, "http://www.patents.com."²⁰

In fact, except for two instances, none of the third-party promotional references to applicant's services utilizes the term "PATENTS.COM" in the manner of a service mark. Of those two instances, moreover, there is nothing in the record to indicate how extensive such uses have been and hence, no way to gauge their impact, if any, on the relevant public for applicant's services. Specifically, while the previously noted reference to "Patents.com by Oppedahl & Larson," which appears on a webpage provided by "Computer Tutor, Inc. of Fort Collins[,] Colorado" under the notation "Links to additional trademark information:," as well as the previously mentioned "HotSites" page from the "InfoWorld" website, which utilizes the term "Patents.com" as a link to applicant's "http://www.patents.com" website, use the term "Patents.com" in the manner of a service mark, there is no indication as how frequently such links have been visited or even how long they have existed (if in fact they did exist for more

²⁰ As recognized, however, by the Board in *In re Eilberg*, supra:

This is not to say that, if used appropriately, the asserted mark or portions thereof may not be trademarks or service marks. For example, if applicant's law firm name were, say, EILBERG.COM and were presented prominently on applicant's letterheads and business cards as the name under which applicant was rendering its legal services, then the mark may well be registrable. However, this is not the case before us.

Likewise, except for the few instances noted above, the same is true herein with respect to the term "PATENTS.COM."

than a short period of time). As Ms. Larson parenthetically but significantly admits in her declaration, "the web is fluid and changes frequently."

Furthermore, with respect to applicant's evidence concerning the number of hits or visits to its website and the various third-party websites that link to applicant's website, suffice it to say that aside from the deficiencies previously noted therein, such evidence, like sales figures, is on this record at best only an indication of the popularity of applicant's Internet-based intellectual property law services among those seeking information about patents and does not serve to establish that the term "PATENTS.COM" has acquired distinctiveness. That is, absent evidence showing that such term is used in the manner of a service mark, website traffic data and third-party linkage figures are more indicative of the relevant public's interest in locating information about patents and other intellectual property law subjects than a demonstration that the highly descriptive term "PATENTS.COM" has indeed come to be regarded as a brand or source identifier for informational services of the kind provided by applicant through its commercial website. Here, the sole evidence furnished by applicant of its use of such term in a service mark manner is the third specimen of use, which it submitted with its amendment to allege use on June 28, 2004, but there is absolutely no evidence as to how long the term "PATENTS.COM" has been so used nor is there any evidence that applicant has advertised or otherwise promoted its services. Applicant, therefore, has failed to provide sufficient proof that

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the highly descriptive term "PATENTS.COM" has acquired distinctiveness. See, e.g., In re Steelbuilding.com, supra at 75 USPQ2d 1424.

Decision: The refusals to register are affirmed.